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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,755	06/04/2001	Maurice Clarence Kemp	MORN-0010 (108347.00021)	2361
25555	7590	01/27/2005	EXAMINER CHOI, FRANK I	
JACKSON WALKER LLP 2435 NORTH CENTRAL EXPRESSWAY SUITE 600 RICHARDSON, TX 75080			ART UNIT 1616	PAPER NUMBER

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/873,755

**Applicant(s)**

KEMP ET AL.

**Examiner**

Frank I Choi

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-20,22-25,27-33,35-59,65,67-73 and 75-102 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-20,22-25,27-33,35-59,65,67-73 and 75-102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The amendment filed 9/28/2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant has amended the Specification to state "1422160 ppm" at page 12, line 5 instead of "7356000 ppm" Applicant provides no evidence which supports the conclusion that one of ordinary skill in the art would recognize the original value as being too high.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-9, 11-20, 22-25, 27-33, 35-59, 65, 67-73, 75-102 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the claims to indicate that for every mole of sulfuric acid, the calcium hydroxide and calcium salt

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used is less than or equal to 0.45 moles. However, the only mole ratios cited by Applicant were 0.45, 0.44 and 0.31. Applicant additionally cites to higher Normalities, however, Applicant provides no indication as to the mole ratio of sulfuric acid to the calcium salt. In any case, the limitation of "less than or equal to 0.45" would still include mole ratios which appear to be outside the scope of the written description even taking into account solutions having normality as high as 36 N. See *In re Wertheim*, 191 USPQ 90,97 (CCPA 1976) (holding that claim language which recited "at least 35%" was not supported by the written disclosure as it read literally on embodiments outside the disclosed range of 25-60%). Applicant's reliance on *Ex Parte Jackson* and *Ziegler v. Phillips Petroleum* is misplaced. The passage cited by Applicant with respect to *Ex Parte Jackson* dealt with the issue of indefiniteness not new matter and amount ranges. Similarly, the passage cited by Applicant with respect to *Zeigler* did not involve the issue of amount ranges and new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,3-9,11-15,17-20,22-25,27-33,35-38,40-59,65,67-73,75-79,81-102 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13,39-41,79 of U.S. Patent Application Serial No. 09/500,473 or claims 19,38,51-56 of U.S. Patent Application Serial No. 09/655,131, each in view of Schwank (US Pat. 5,087,467), Roden et al. (US Pat. 6,375,976) and Wurzbürger et al. (US Pat. 6,331,514).

Said US Applications disclose in said claims compositions containing calcium salt, such as calcium sulfate or calcium hydroxide, and sulfuric acid.

Schwank (US Pat. 5,087,467), Roden et al. (US Pat. 6,375,976) and Wurzbürger et al. (US Pat. 6,331,514) were cited in the prior Office Action and the same are incorporated herein.

The difference between the claims of said US Applications and the claims of the present invention is that the claims of said US Applications do not include a salt of phosphorous. However, the prior art amply suggests the same as it disclosed to use salts of phosphorus for treatment of produce. Further, the prior art discloses the use of calcium salts and sulfuric acid for treatment of produce. As such, it would have been well within the skill of and one ordinary skill in the art would have been motivated to modify the claims of said US applications with the expectation that the combination would be suitable for treatment of produce.

Therefore, the claimed invention, as a whole, would have been an obvious modification of the claims of said US Patent Applications to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the claims of said Applications and the prior art references.

This is a provisional obviousness-type double patenting rejection.

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Claims 1,3-9,11-15,17-20,22-25,27-33,35-38,40-59,65,67-73,75-79,81-102 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of US Pat. 6,572,908 in view of Schwank (US Pat. 5,087,467), Roden et al. (US Pat. 6,375,976) and Wurzburger et al. (US Pat. 6,331,514).

Said US Patent claims a nutriment which is treated with a composition containing calcium salt, such as calcium sulfate or calcium hydroxide, and sulfuric acid.

Schwank (US Pat. 5,087,467), Roden et al. (US Pat. 6,375,976) and Wurzburger et al. (US Pat. 6,331,514) are cited for the same reasons as above and are incorporated herein to avoid repetition.

The difference between the claim of said US Patent and the claims of the present invention is that the claim of said US Patent does not include a salt of phosphorous. However, the prior art amply suggests the same as it disclosed to use salts of phosphorus for treatment of produce. Further, the prior art discloses the use of calcium salts and sulfuric acid for treatment of produce. As such, it would have been well within the skill of and one ordinary skill in the art would have been motivated to modify the claim of said US Patent with the expectation that the combination would be suitable for treatment of produce.

Therefore, the claimed invention, as a whole, would have been an obvious modification of the claims of said US Patent to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the claims of said Applications and the prior art references.

Examiner has duly considered Applicant's arguments but deems them unpersuasive. Although a terminal disclaimer was filed, it only recited 09/500,473 not 09/655,131 or US Pat. 6,572,908. As such, the terminal disclaimer is improper.

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***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Gary Kunz, can be reached at 571-272-0887. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

FIC

January 22, 2005



JOHN PAK  
PRIMARY EXAMINER  
GROUP 1600